

TAW AF 3626

TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
BEC-0041

In Re: Application Of: SETH P. BECKER ET AL

Application No.	Filing Date	Examiner	Customer No.	Group Art Unit	Confirmation No.
10/020,728	October 29, 2001	Kalinowski	23413	3626	9760

Invention: METHOD AND SYSTEM FOR PROVIDING REGISTRATION AND LOSS PROTECTION SERVICES TO SONSUMER JEWELRY OWNERS

COMMISSIONER FOR PATENTS:

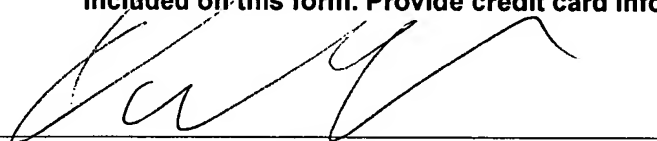
Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:

☒ Applicant claims small entity status. See 37 CFR 1.27

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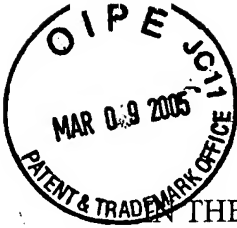
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THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SETH P. BECKER ET AL)
Serial No. 10/020,728) Group Art Unit: 3626
Filed: October 29, 2001) Examiner:
For: METHOD AND SYSTEM FOR PROVIDING) Kalinowski
REGISTRATION AND LOSS PROTECTION)
SERVICES TO CONSUMER JEWELRY)
OWNERS)

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APPEAL BRIEF

REAL PARTY IN INTEREST

The real party in interest is DIAMOND I.D., INC., the assignee of record as
recorded at reel/frame 012612/0291.

03/10/2005 HAL111 00000018 061130 10020728

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RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

STATUS OF CLAIMS

Claims 2-9, 11-14, 16-22, 24 and 27-29 stand rejected.

The rejections of claims 2-9, 11-14, 16-22, 24 and 27-29 are herein appealed.

STATUS OF AMENDMENTS

An amendment was filed on December 29, 2004 after the final rejection of October 5, 2004. The status is unknown at this time as no response has been received from the Examiner.

SUMMARY OF CLAIMED SUBJECT MATTER

A concise explanation of the subject matter defined in each of the independent claims 11 and 24 involved in the appeal is provided below.

Claim 11

Claim 11 is directed to a system for providing registration services and loss protection services related to jewelry. The system provides the ability for a provider of loss protection services (e.g., an insurer) to insure jewelry prior to the jewelry being transferred to a consumer. No existing systems provide this feature. Typically, jewelry is insured by the consumer paying an additional insurance premium upon the purchase of jewelry.

The system includes a database (112) for registering the jewelry and a loss protection system (110) in communication with the database for bundling the registration

services and the loss protection services (e.g., insurance) related to the jewelry such that the registration services and the loss protection services are associated with the jewelry item regardless of ownership. The registration services and the loss protection services are provided to a consumer. The loss protection services are bundled with the registration services before transfer of ownership of a jewelry item to a consumer, a cost of the loss protection services bundled with the registration services being included in a cost of the jewelry item to the consumer.

Claim 24

Claim 24 is directed to a method for providing registration services and loss protection services related to jewelry. The method includes initiating the registration services by registering a jewelry item in a database (206). The loss protection services are initiated when the jewelry is obtained by a dealer/sightholder at step 202. The registration services and the loss protection services are bundled at step 204 such that the registration services and the loss protection services are associated with the jewelry item regardless of ownership. The registration services and the loss protection services are provided to a consumer at step 214 when the consumer purchases the jewelry. The database is updated upon an occurrence of an event relating to the jewelry item at 220. The loss protection services are bundled with the registration services at step 204 before transfer of ownership of a jewelry item to the consumer at step 214. A cost of the loss protection services bundled with the registration services is included in a cost of the jewelry item to the consumer.

The above exemplary embodiments are discussed with respect to the aforementioned independent claims by way of example only and are not intended to in any way limit the scope of these claims.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 2, 3, 5, 8, 9, 11, 13, 14, 16-22, 24, 27 and 29¹ were rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield.

Claim 4 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and Official Notice.

Claims 6-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and Jewelers Mutual.

Claim 12 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and S&P.

Claim 28 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and S&P.

ARGUMENT

Claims 2, 3, 5, 8, 9, 11, 13, 14, 16-22, 24, 27 and 29

Claims 2, 3, 5, 8, 9, 11, 13, 14, 16-22, 24, 27 and 29 were rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield.

In rejecting claim 11, the Examiner cites Becker as teaching bundling registration services with loss protection services. Applicants respectfully disagree. Claim 11 recites “bundling said registration services and said loss protection services related to said jewelry such that said registration services and said loss protection services are associated with said jewelry item regardless of ownership, said registration services and said loss protection services are provided to a consumer.” Becker teaches that insurance companies may contact the central headquarters to inquire about information relating to a gemstone’s owner or its characteristics. Becker does not teach the offering of insurance

¹ The final rejection of October 5, 2004 has a typographical error on page 9, where reference to “claim 24” should read “claim 29.”

services. Becker fails to teach bundling registration and loss protection services such as insurance, replacement coverage and warranty.

The Examiner relies on GemShield as teaching loss protection services bundled with registration services before the jewelry is transferred to the consumer with a cost of the loss protection services bundled with the cost of the jewelry. Applicants respectfully disagree with this interpretation of GemShield.

The cited section of GemShield reads “[a]s a marketing incentive, you can purchase the first year’s insurance for your customers. You receive a flat rate for each piece of jewelry you sell. You simply forward an application to us with a description and its selling price. At the end of each month, we send you a report of items sold and total premiums due. You simply send the payment to IJB” (emphasis added).

GemShield teaches that the retailer or consumer pays for the loss protection service. The cost is not automatically built into the cost of the jewelry. In fact, in GemShield, the retailer or consumer pays the insurance premium which is contrary to including this cost in the cost of the jewelry item. In GemShield, the retailer does not know the costs until an application is submitted and a report is received at the end of the month including the premium. The costs under the GemShield program are also geographically dictated such that different insurance premiums are required for different geographic locations. In embodiments of the invention, the cost of the loss protection services are not geographically dictated because the loss protection services are initiated before the jewelry reaches its end location, the consumer.

Thus, GemShield does not teach “loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the jewelry item to the consumer” as recited in claim 11. Furthermore, in GemShield, there is an application for loss protection which is subject to approval. In the

system of claim 11, there is no application subject to approval. The consumer receives the registration services and the loss protection services automatically and immediately.

In the final rejection, the Examiner states that Becker teaches both registration and loss protection services. Applicants respectfully disagree. The loss protection services as described in the specification and used in the claims are above and beyond the registration services taught by Becker. The registration services in Becker can be used to notify police or insurance companies of loss of a jewelry item. The registration services of Becker, however, are not loss protection services that provide replacement or repair value as described in Applicants' specification. The loss protection services may be an insurance policy that is tied to the jewelry such that end consumers are already protected upon purchase of the jewelry without initiating a separate policy. Thus, the claimed registration services and loss protection services are not both taught by Becker.

Even if Becker and GemShield are combined, the invention of claim 11 does not result. Thus, claim 11 is patentable over Becker in view of Gemshield. Claims 2, 3, 5, 8, 9, 13 and 14 depend from claim 11 and are patentable over Becker in view of Gemshield for at least the reasons advanced with respect to claim 11.

Claim 24 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield. Claim 24 is similar to claim 11 and is patentable over Becker in view of GemShield for at least the reasons advanced with respect to claim 11. Claims 16-22, 27 and 29 depend from claim 24 and are patentable over Becker in view of GemShield for at least the reasons advanced with respect to claim 24.

Claim 4

Claim 4 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and Official Notice.

Claim 4 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and Official Notice. The Official Notice does not cure the

deficiencies of Becker and GemShield discussed above with reference to claim 11. Thus, claim 4 is patentable over Becker in view of GemShield and Official Notice.

Claims 6-7

Claims 6-7 were rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and Jewelers Mutual.

Claims 6 and 7 were rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and Jewelers Mutual. Jewelers Mutual does not cure the deficiencies of Becker and GemShield discussed above with reference to claim 11. Thus, claims 6 and 7 are patentable over Becker in view of GemShield and Jewelers Mutual.

Claim 12

Claim 12 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and S&P.

As noted above, Becker and Gemshield fail to teach the elements of claim 11, thus adding S&P does not cure these deficiencies. Further, S&P fails to disclose “a wholesaler includes the registration services and loss protection services in the cost of the jewelry item, the wholesaler transferring the jewelry item to at least one entity prior to the consumer obtaining the jewelry item” as recited in claim 12. S&P states insurance coverage is offered for wholesalers, but this does not teach or suggest including such insurance coverage with the cost of the jewelry. The proper interpretation of S&P is that the wholesaler has insurance for their own inventory prior to transfer. The insurance is not bundled or associated with the jewelry that is being sold to retailers and consumers as recited in claim 12. In fact, S&P discloses differing insurance programs for wholesalers and personal coverage.

Thus, even if Becker, Gemshield and S&P are combined, the invention of claim 12 does not result. Thus, claim 12 is patentable over Becker in view of Gemshield and S&P.

Claim 28

Claim 28 was rejected under 35 U.S.C. § 103 as being unpatentable over Becker in view of GemShield and S&P.

Claim 28 indicates that “a wholesaler initiates the registration services and initiates the loss protection services.” In GemShield, rates are based upon the retail selling price (the price the consumer pays the retailer) or appraised value. In the method of claim 28, the rate is based upon the wholesale value as the loss protection is initiated at the wholesale level. In GemShield, the retailer or the consumer pays for the loss protection services after the purchase by the consumer. With GemShield, the retailer must sell the item to a consumer and then an application is sent to GemShield. Then, a report is sent to the retailer of items sold and premiums due, which either the retailer or the consumer pays. The jewelry is covered only when the premium is paid. In the method of claim 28, a report is generated when the wholesaler sells the item to a retailer (obviously, prior to the item being sold to a consumer) and a premium/fee automatically covers all the items, immediately upon the consumer’s purchase. Furthermore, in GemShield any loss will be replaced by the trusted retailer jeweler. This translates into the retailer jeweler receiving the replacement income.

Further, S&P fails to disclose “a wholesaler initiates the registration services and initiates the loss protection services” as recited in claim 28. S&P states insurance coverage is offered for wholesalers, but this does not teach or suggest including such insurance coverage with the cost of the jewelry. The proper interpretation of S&P is that the wholesaler has insurance for their own inventory prior to transfer. The insurance is not bundled or associated with the jewelry that is being sold to retailers and consumers as

recited in claim 28. In fact, S&P discloses differing insurance programs for wholesalers and personal coverage.

Thus, even if Becker, Gemshield and S&P are combined, the invention of claim 28 does not result. Thus, claim 28 is patentable over Becker in view of Gemshield and S&P.

CONCLUSION

In view of the foregoing, it is urged that the final rejection of claims be reversed.

The fee as set forth in 37 CFR § 41.20(b)(2) is enclosed herewith.

If there are any charges with respect to this Appeal Brief or otherwise, please charge them to Deposit Account No. 06-1130 maintained by Applicants' attorneys.

Respectfully submitted,

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Date: March 7, 2005

CLAIM APPENDIX

2. The system of claim 11 wherein said database includes ownership data related to said jewelry.

3. The system of claim 11 wherein said database includes distinguishing characteristics of said jewelry for tracking and identification purposes.

4. The system of claim 11 wherein said database includes fees collected and owed.

5. The system of claim 11 wherein said database includes value of said jewelry.

6. The system of claim 11 wherein said loss protection systems provides said database with policy data relating to coverage terms selected.

7. The system of claim 11 wherein said loss protection systems provides said database with updated inspection data relating to said jewelry.

8. The system of claim 11 wherein said loss protection systems provides said database with transfer of ownership data.

9. The system of claim 11 wherein said loss protection systems provides said database with occurrence of events relating to said jewelry including one of theft, loss, destruction and recovery.

11. A system for providing registration services and loss protection services related to jewelry, comprising:

a database for registering said jewelry; and

a loss protection system in communication with said database for bundling said registration services and said loss protection services related to said jewelry such that said registration services and said loss protection services are associated with said jewelry item regardless of ownership, said registration services and said loss protection services are provided to a consumer;

wherein said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to a consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the jewelry item to the consumer.

12. The system of claim 11 wherein a wholesaler includes the registration services and loss protection services in the cost of the jewelry item, the wholesaler transferring the jewelry item to at least one entity prior to the consumer obtaining the jewelry item.

13. The system of claim 11 wherein the database and the loss protection system are implemented by the same system.

14. The system of claim 11 wherein the database includes an identification of marking on the jewelry item.

16. The method of claim 24 wherein the updating said database occurs upon one of a transfer of ownership, loss, destruction, theft, damage, recovery and settlements initiated.

17. The method of claim 24 wherein terms of loss protection services include identification information for said jewelry item.

18. The method of claim 24 wherein terms of loss protection services include a value of said jewelry item.

19. The method of claim 24 wherein terms of loss protection services include ownership information related to said jewelry item.

20. The method of claim 24 wherein said jewelry item includes a jewelry item that has been marked with an identification marking.

21. The method of claim 24 wherein said database is a commercial database accessible by authorized entities.

22. The method of claim 24 wherein said initiating said loss protection service agreement includes collecting activation information for a provider of said loss protection services.

24. A method for providing registration services and loss protection services related to jewelry, comprising:

initiating said registration services by registering a jewelry item in a database;

initiating said loss protection services;

bundling the registration services and the loss protection services such that said registration services and said loss protection services are associated with said jewelry item regardless of ownership, said registration services and said loss protection services are provided to a consumer;

providing the bundled registration services and loss protection services to a consumer; and,

updating said database upon an occurrence of an event relating to said jewelry item;

wherein said loss protection services are bundled with said registration services before transfer of ownership of a jewelry item to the consumer, a cost of said loss protection services bundled with said registration services being included in a cost of the jewelry item to the consumer.

27. The method of claim 24 wherein the registration services and the loss protection services are provided by the same entity.

28. The method of claim 24 wherein:

a wholesaler initiates the registration services and initiates the loss protection services.

29. The method of claim 24 wherein:

said registration services include storing one or more characteristics of the jewelry.